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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/097,221	06/12/1998	RICHARD L. BERTRAM	LINAB-48525	2701

7590 11/02/2004

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EXAMINER

NOLAN, SANDRA M

ART UNIT PAPER NUMBER

1772

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/097,221

Applicant(s)

BERTRAM

Examiner

Sandra M. Nolan

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2004 and 22 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: 9-17-04 cover sheet.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04 March 2004 has been entered.

Timeliness of Response to Notice of Non-Compliant Amendment

2. The Notice of Non-compliant Amendment bearing an eDAN/IFW mailing date of 09 March 2004 was actually mailed to applicants' attorney on 17 September 2004.

A copy of the cover page for that mailing, which shows a handwritten mailing date of "9-17-04" and applicant's law firm's "RECEIVED" date stamp for "SEP 21 2004", shows that the notice was mailed on 17 September 2004.

Accordingly, the 22 September 2004 response to the notice was a timely submission.

Claims

3. Claims 47-61 are pending.

Withdrawal of Allowance

4. The allowance of claims 54-60 is withdrawn in order to apply a new rejection.

Rejection Withdrawn

5. The 35 USC 112 rejection of claims 47-49, 51-53 and 61 for new matter is withdrawn in view of applicant's amendment to claim 47 in the 22 September 2004 response.

Reinstated Rejection

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 47-49, 51-53 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bertram (US 4,792,493) in view of Ranney et al (US 4,015,044) for reasons of record.

Bertram, Ranney and their application under 35 USC 103 are discussed in section 8 of the 16 July 2002 office action.

New Rejection

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 47-61 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,673,193 in view of Ranney.

The '193 patent claims methods for bonding PVC sheets with urethane sheets by applying a hydroxyl-containing resin to the PVC sheet and bonding them to urethane sheets. The sheets are used to line conduits. Claim 2 of the patent says that the urethane sheets are bonded to concrete.

The '193 patent fails to teach silanes

Ranney is discussed in section 8 of the 16 July 2002 office action. In claim 1 of the patent, it teaches the use of silanes to enhance the bonding of urethanes to inorganic surfaces.

The references are analogous because they both deal with urethane adhesives.

The motivation to employ the silanes of Ranney in the method of the '193 patent is found in claim 1 of Ranney, where silanes are taught to enhance the bonding of urethanes to inorganic surfaces.

It would have been obvious to one having ordinary skill in the art at the time of the invention to employ the silanes of Ranney in the process of the '193 patent in order to enhance the bond between the urethane and the concrete.

It is deemed beneficial to enhance the adhesion of the urethane intermediate layer to the concrete in order to strengthen the adhesion of the PVC/urethane liners to concrete conduits.

Response to Arguments

11. Applicant's arguments filed in the 22 September 2004 response have been fully considered but they are not persuasive.

On pages 10-18 of that response, applicant argues that the instant claims differ in various ways from the teachings of Bertram ("the '493 patent"). However, applicants say nothing about the Ranney teachings or the propriety of the combination of the Bertram and Ranney teachings.

Nonetheless, the examiner will respond to the arguments in the order in which they were presented.

On page 11, applicant asserts that covalent bonds are not formed between the hydroxyl groups and isocyanato groups in the '493 patent.

However, applicant presents no objective support for this assertion. Subjective statements, with no objective support are not persuasive. MPEP 2145(I).

On page 12, applicant asserts that covalent bonds are not formed between the thermoplastic sheet and the urethane primer-activator in the '493 patent.

However, applicant presents no objective support for this assertion. Subjective statements, with no objective support are not persuasive. MPEP 2145(I).

On pages 12-13, applicant asserts that the urethane primer-activator does not impregnate the thermoplastic sheet in the '493 patent.

However, applicant presents no objective support for this assertion. Subjective statements, with no objective support are not persuasive. MPEP 2145(I).

On pages 16-17, applicants argue that the hydroxyl-bearing resin of the invention penetrates deeply into the thermoplastic sheet and that the thus-impregnated hydroxyl groups react with the isocyanato groups from the thermosetting urethane and the urethane diffuses into the internal structure of the thermoplastic sheet.

However, applicant points to no objective support in the specification for this assertion.

Furthermore, claim 47 says only that "an interface" between the urethane and thermoplastic layers is bonded, with no recitation of deep penetration or diffusion of the urethane into the thermoplastic layer.

On page 17, applicant asserts that, in the instant invention, the hydroxyl-bearing resin impregnates the thermoplastic sheets so that ambient moisture cannot react with it and compromise bonding, as allegedly suggested by the '493 patent.

However, applicant presents no objective support for this assertion. Subjective statements, with no objective support are not persuasive. MPEP 2145(I).

Conclusion

Any inquiry concerning this communication should be addressed to Sandra M. Nolan, at telephone number 571/272-1495. She can normally be reached Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the examiner are unsuccessful, her supervisor, Harold Pyon, can be reached at 571/272-1498.

The fax number for patent application documents is 703/872-9306.



S. M. Nolan
Primary Examiner
Technology Center 1700

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